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**SOLICITOR**

**REPORT ON THE  
 FILING OR DETERMINATION OF AN  
 ACTION REGARDING A PATENT OR  
 TRADEMARK**

In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been  
 filed in the U.S. District Court \_\_\_\_\_ of Northern California on the following ☒ Patents or ☐ Trademarks:  
 U.S. PATENT & TRADEMARK OFFICE

DOCKET NO. <b>CV 07-04338 HRL</b>	DATE FILED <b>08/22/2007</b>	U.S. DISTRICT COURT <b>280 South First Street, San Jose, Ca 95113</b>
PLAINTIFF <b>UPEK, INC.</b>		DEFENDANT <b>IDEX ASA, ET AL</b>
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
<b>1 7,110,577</b>		(See attached complaint)
<b>2</b>		
<b>3</b>		
<b>4</b>		
<b>5</b>		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
<b>1</b>			
<b>2</b>			
<b>3</b>			
<b>4</b>			
<b>5</b>			

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
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CLERK  Richard W. Wicking	(BY) DEPUTY CLERK  Tiffany Salinas-Harwell	DATE  August 23, 2007
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner  
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

COPY

1 JEFFREY A. MILLER (STATE BAR NO. 160602)  
2 ORRICK, HERRINGTON & SUTCLIFFE LLP  
3 1000 Marsh Road  
4 Menlo Park, CA 94025  
5 Telephone: 650-614-7400  
6 Facsimile: 650-614-7401

ORIGINAL

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RIGHT TO REMOVAL

U.S. DISTRICT COURT

7 Attorneys for Plaintiff  
8 UPEK, INC.

ADR

9 UNITED STATES DISTRICT COURT  
10 NORTHERN DISTRICT OF CALIFORNIA

11 C07 04338 HRL

12 UPEK, INC., a Delaware corporation,

13 Plaintiff,

14 v.

15 IDEX ASA,  
16 IDEX AMERICA INC., a Delaware  
17 corporation, and  
STIFTELSEN FOR INDUDSTRIELL OG  
TEKNISK FORSKNING VED NTH.

18 Defendants.

COMPLAINT FOR DECLARATORY  
JUDGMENT OF NON-  
INFRINGEMENT AND INVALIDITY  
OF U.S. PATENT NO. 7,110,577

DEMAND FOR JURY TRIAL

19  
20  
21 Plaintiff UPEK, Inc. ("UPEK"), hereby demands a jury trial, and for its complaint against  
22 Defendants IDEX ASA ("IDEX"), IDEX America Inc. ("IDEX AMERICA") and STIFTELSEN  
23 FOR INDUDSTRIELL OG TEKNISK FORSKNING VED NTH ("SINTEP") alleges as follows:

24 NATURE OF THE ACTION

25 1. This is an action for declaratory relief brought pursuant to the Declaratory  
26 Judgment Act, 28 U.S.C. § 2201, and arises under the patent laws of the United States, 35 U.S.C.  
27 § 271 *et seq.* This action seeks declaratory relief of non-infringement and invalidity of U.S.  
28

1 Patent No. 7,110,577, entitled "Method and Apparatus For Measuring Structures in a  
2 Fingerprint."

3 **JURISDICTION AND VENUE**

4 2. This Court has jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and  
5 1338(a).

6 3. Venue is proper in this District pursuant to 28 U.S.C. §§ 1391(b)-(d) and 1400(b).  
7 Plaintiff UPEK is a Delaware corporation with a principal place of business in Emeryville, CA.  
8 A substantial part of the events or omissions which give rise to some of the claims occurred at  
9 UPEK's principal business in Emeryville, CA. On information and belief, Defendant IDEX is a  
10 company incorporated in Norway, with its principal place of business in Fornebu, Norway. On  
11 information and belief, IDEX maintains a U.S. sales, marketing and operations office, IDEX  
12 America Inc. in Foster City, California. On information and belief, Defendant IDEX AMERICA  
13 is a corporation incorporated in Delaware, and maintains a sales, marketing and operations office  
14 in Foster City, California. On information and belief, Defendant SINTEF is a foundation  
15 incorporated under the laws of Norway, with its principal place of business in Trondheim,  
16 Norway.

17 **THE PARTIES**

18 4. Plaintiff UPEK is a Delaware corporation with a principal place of business in  
19 Emeryville, California, at 2200 Powell Street, Suite 300, Emeryville, CA 94608, which is in this  
20 district. UPEK manufactures and sells fingerprint authentication solutions that can be integrated  
21 into a variety of commercial applications, including personal laptop computers.

22 5. On information and belief, Defendant IDEX is a company incorporated in Norway,  
23 with its principal place of business in Fornebu, Norway. On information and belief,  
24 IDEX supplies fingerprint sensing products globally, including in the United States. On  
25 information and belief, IDEX maintains a U.S. sales, marketing and operations office, IDEX  
26 America Inc. in Foster City, California.

27 6. On information and belief, Defendant IDEX AMERICA is a corporation  
28 incorporated in Delaware, and maintains a sales, marketing and operations office in Foster City,

1 California. On information and belief, IDEX AMERICA supplies fingerprint sensing products in  
2 the United States.

3 7. On information and belief, Defendant SINTEF is a foundation incorporated under  
4 the laws of Norway, with its principal place of business in Trondheim, Norway.

5 **FACTUAL BACKGROUND**

6 8. UPEK manufactures various fingerprint authentication solutions that can be  
7 integrated into a variety of commercial and non-commercial applications.

8 9. On April 20, 2007, Defendants IDEX and SINTEF filed a complaint for patent  
9 infringement against UPEK in the United States District Court for the District of Delaware. *See*  
10 Exhibit A (*STIFTELSEN FOR INDUDSTRIELL OG TEKNISK FORSKNING VED NTH and*  
11 *IDEX ASA v. UPEK, Inc.*, No. 1:07-cv-00214-GMS) (the "4/20/2007 Complaint").

12 10. The complaint alleged that the inventor of U.S. Patent No. 7,110,577 (the "'577  
13 patent"), entitled "Method and Apparatus For Measuring Structures in a Fingerprint" had  
14 assigned the '577 patent to SINTEF, and that SINTEF had granted IDEX an exclusive license to  
15 the '577 patent. *Id.* at ¶7-10.

16 11. The complaint further alleged that UPEK infringed the '577 patent by making,  
17 using, offering to sell, selling, and/or importing methods and apparatus embodying the patented  
18 invention. *Id.* at ¶11.

19 12. On August 17, 2007, nearly four months after filing, IDEX withdrew its 4/20/2007  
20 complaint against UPEK without prejudice.

21 13. In sum, Defendants IDEX and SINTEF have displayed their intention to  
22 vigorously enforce their intellectual property rights relating to fingerprint authentication  
23 technology. IDEX and SINTEF have specifically alleged UPEK of infringing the '577 patent.

24 14. Consequently, Plaintiff UPEK has a reasonable apprehension of imminent suit for  
25 alleged infringement of the '577 patent.

26 **GENERAL ALLEGATIONS**

27 15. Plaintiff UPEK incorporates by reference the allegations of paragraphs 1-14 as  
28 though fully set forth herein.

17. Defendants IDEX and SINTEF have alleged that UPEK infringed the '577 patent by making, using, offering to sell, selling, and/or importing methods and apparatus embodying the patented subject matter of the '577 patent. UPEK therefore has a reasonable apprehension that IDEX, IDEX AMERICA, and SINTEF will file a patent infringement suit based on the '577 patent against UPEK.

**COUNT I**

**For Declaratory Judgment of Non-infringement of the '577 Patent**

18. Defendant UPEK incorporates by reference the allegations of paragraphs 1-17 as though fully set forth herein.

19. UPEK denies that any of its products infringes or has infringed any valid claim of the '577 patent directly, indirectly, contributorily, or otherwise.

20. Accordingly, UPEK seeks a Declaratory Judgment from this Court pursuant to Federal Rule of Civil Procedure 57 and 28 U.S.C. § 2201, that the '577 patent is not infringed by UPEK.

21. A judicial declaration is necessary and appropriate at this time so that UPEK may ascertain its rights and duties with respect to the manufacture and sale of its products that IDEX and SINTEF has alleged infringe the '577 patent.

**COUNT II**

### **For Declaratory Judgment of Invalidity of the '577 Patent**

22. Defendant UPEK incorporates by reference the allegations of paragraphs 1-21 as though fully set forth herein.

23. UPEK contends that the '577 patent is invalid for failure to comply with the patent laws of the United States, including, without limitation, the provisions of 35 U.S.C. §§ 101, 102, 103, and 112.

1           24. Accordingly, UPEK seeks a declaratory judgment that the '577 patent is invalid for  
2 failure to comply with the patent laws of the United States, including, without limitation, the  
3 provisions of 35 U.S.C. §§ 101, 102, 103 and 112.

4           25. A judicial declaration is necessary and appropriate at this time so that UPEK may  
5 ascertain its rights and duties with respect to the manufacture and sale of its products that IDEX  
6 and SINTEF have alleged infringe the '577 patent.

7                                   **COUNT III**

8                                   **(Attorney Fees)**

9           26. UPEK hereby incorporates by reference the allegations of paragraphs 1 through 25  
10 as though fully set forth herein.

11           27. This case is exceptional as defined under 35 U.S.C. § 285, thereby entitling UPEK  
12 to reasonable attorney fees.

13                                   **PRAYER FOR RELIEF**

14           WHEREFORE, UPEK respectfully requests that this Court:

15           A. Enter judgment declaring that UPEK has not infringed and does not infringe the  
16 '577 patent, directly, indirectly, or contributorily;

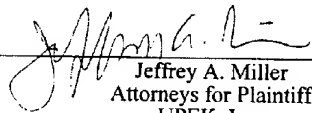
17           B. Enter judgment declaring that the '577 patent is invalid;

18           C. Declare this case exceptional under 35 U.S.C. § 285 and award UPEK its costs,  
19 disbursements, and attorney's fees incurred in this action; and

20           D. Order such relief as the Court deems just and equitable.

21  
22                                   ORRICK, HERRINGTON & SUTCLIFFE LLP

23  
24           Dated: August 22, 2007

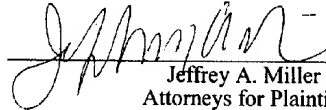
25                                     
26                                   Jeffrey A. Miller  
27                                   Attorneys for Plaintiff  
28                                   UPEK, Inc.

**JURY DEMAND**

UPEK demands a trial by jury of all issues so triable.

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: August 22, 2007

  
Jeffrey A. Miller  
Attorneys for Plaintiff  
UPEK, Inc.

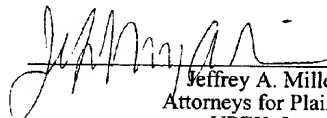
**CERTIFICATE OF INTERESTED ENTITIES OR PERSONS**

Pursuant to Civil L.R. 3016, the undersigned certifies that the following listed persons, associations of persons, firms, partnerships, corporations (including parent corporations) or other entities (i) have a financial interest in the subject matter of controversy or in a party to the proceeding, or (ii) have a non-financial interest in that subject matter or in a party that could be substantially affected by the outcome of this proceeding:

1. UPEK R&D s.r.o. Subsidiary of UPEK, Inc.
2. UPEK PTE LTD. Subsidiary of UPEK, Inc.
3. UPEK K.K. Subsidiary of UPEK, Inc.

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: August 22, 2007

  
Jeffrey A. Miller  
Attorneys for Plaintiff  
UPEK, Inc.